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Ralph E. Jocke

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&  
Trademark Law

September 10, 2001

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

Re: **Application Serial No.:** 09/077,337  
**Appellants:** Jay Paul Drummond, et al.  
**Title:** Automated Banking Machine  
Apparatus and System  
**Docket No.:** D-1077

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

Please charge the fee required with this filing (\$310) and any other fee due to Deposit Account 09-0428.

Very truly yours,



Ralph E. Jocke  
Reg. No. 31,029

Void Date: 09/19/2001 - SCOTTON  
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BOARD OF PATENT APPEALS  
AND INTERFERENCES

In re Application of: **Jay Paul Drummond, et al.** )

Serial No.: **09/077,337** )

Art Unit 2164

Filed: **May 27, 1998** )

Patent Examiner

James S. Bergin

Title: **Automated Banking Machine  
Apparatus and System** )

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

09/19/2001 SCOTTON 00000001 09077337

**BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192**

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Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,  
concerning the above-referenced Application.

**REAL PARTY IN INTEREST**

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Diebold, Incorporated, an Ohio corporation.

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## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-54 are pending in the Application. Claims 1-30, 32-34, 36-37, 39-40, 42-43, and 46-47 have been withdrawn from consideration.

A Petition for Withdrawal of a Restriction Requirement was filed by Appellants on July 10, 2001. As of the writing of this Appeal Brief, Appellants had not yet received a response by the Office in regard to their Petition. Appellants reserve all rights regarding the Office's response to the Petition, including the filing of a Supplemental Appeal Brief.

Claims 31, 35, 38, 41, 44-45, and 48-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the article "U.S. Bancorp, Microsoft Paving New Roads to On-line Banking" (hereinafter "U.S. Bancorp").

These rejections were the only rejections present in the Office Action ("Action") dated June 19, 2001. Appellants appeal each claim rejection, inclusive.

## **STATUS OF AMENDMENTS**

No final rejection has been made. However, claims have been twice rejected. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

## **SUMMARY OF INVENTION**

### **Overview of the Invention**

In an exemplary embodiment an automated banking machine (an ATM) includes a computer which has a browser or other HTML document handling software operating therein. The automated banking machine also includes a sheet dispenser, such as a currency note dispenser. The automated banking machine is connected to a local or wide area network and may operate to receive HTML documents. The HTML documents may include instructions that are processed by the HTML document handling software. The banking machine of the exemplary embodiment can operate in response to instructions included in the received HTML documents to control the dispenser to dispense currency notes. Exemplary embodiments used in connection with a wide area network may provide a user with a familiar user interface from their home institution even when the user uses a banking machine operated by another institution.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are whether Appellants' claims 31, 35, 38, 41, 44-45, and 48-54 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Bancorp.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Each of Appellant's claims 31, 35, 38, 41, 44-45, and 48-54 recite at least one element or combination of elements not found or suggested in the U.S. Bancorp reference, which patentably distinguishes the claims.

Every claim recites additional features of the invention which patentably distinguishes the claim over every other pending claim.

The rejected claims include six independent claims (claims 31, 35, 38, 41, 44, and 51). Claim 45 depends from claim 44. Claim 48 depends from claim 31. Claim 49 depends from claim 35. Claim 50 depends from claim 38. Claims 52-54 depend from claim 51. All of the rejected claims 31, 35, 38, 41, 44-45, and 48-54 are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810

F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The U.S. Bancorp Article**

The U.S. Bancorp article is directed to the desirability of PC home banking. The article refers to the "project" (page 1, line 21), "development" (page 2, line 7), "vision" (page 1, line 34), and how it "aspires to make" (page 1, line 25) banking "available in the home through the PC" (page 1, lines 25-26). However, the article also includes the comment that "There was nothing new there" (page 2, line 63). The article also concludes that "on-line banking has a long way to go" (page 3, lines 20-21).

The detail-deficit information provided in the U.S. Bancorp article can be likened to space travel history. The desire for space travel was dreamed of for many decades while scientists lacked the necessary information to actually reduce it to practice. The U.S. Bancorp

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article corresponds to an infant dream state of PC home banking. For example, the document states that "it aspires to make a full-service branch available in the home through the PC" and "The vision is that the customer would be able to do everything on-line that they can now do in a branch." Part of this aspiration (i.e., dream) would be to "download cash and make deposits" (page 1, line 31). However, the document does not explain how a home PC could enable the PC user to dispense a currency note (receive cash bills from the PC), or deposit a currency note (deposit cash bills into the PC), or cash a check (receive cash bills from the PC). That is, the dream of the article's PC home banking capabilities is far from the real available banking transaction capabilities easily performed at a bank branch. Furthermore, the article's comment about "giving customers access to everything except maybe safe deposit boxes" is taken in the context of a joke (page 1, line 28). *who says*

*THIS IS NOT A VALID INTERPRETATION* The article at best appears limited to suggesting that home PC users could make transfers (e.g., download cash and make deposits) between accounts and use "a live teller through two-way full-motion video" (page 1, lines 26-27). Any other interpretation of the article would constitute adding new matter that is neither disclosed nor suggested in the article.

(iv) **35 U.S.C. § 103**

**The Claims Are Not Obvious Over  
U.S. Bancorp**

Claims 31, 35, 38, 41, 44-45, and 48-54 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Bancorp. These rejections are respectfully traversed. Appellants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the U.S. Bancorp article stricken for the reasons presented herein.

**The U.S. Bancorp Article Does Not Constitute Prior Art**

**Appellants have sworn behind the U.S. Bancorp article**

The U.S. Bancorp article allegedly has a February 16, 1996 date. The present application is entitled to the priority of U.S. provisional application 60/031,956 filed November 27, 1996. Appellants' claims patentably distinguish over the U.S. Bancorp article. Nevertheless, the Declaration filed July 10, 2001 pursuant to 37 C.F.R. § 1.131 swears behind the U.S. Bancorp article.

It is noted that the Declaration filed July 10, 2001, except for mention of the February 16, 1996 date and date of signature, is substantially identical to the prior Declaration filed May 23, 2001. The Office entered the prior Declaration and acknowledged (e.g., Interview Summary) the



effective earlier date set forth by the prior Declaration. Thus, the Declaration filed July 10, 2001 effectively swears behind the U.S. Bancorp article.

It follows that the Offices's reliance on the U.S. Bancorp article is moot in view of the Declaration filed July 10, 2001. That is, the relied upon U.S. Bancorp article does not constitute prior art. Hence, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The U.S. Bancorp article does not constitute a prior art printed publication

Appellants traverse the allegation that the U.S. Bancorp article is a legitimate reference document. Appellants question the accuracy of the date and subject matter of the apparently electronic document. Appellants request evidence of the validity of this document. Appellants request a non-electronic copy version of this allegedly published U.S. Bancorp article.

The Office has presented no proof that an electronic document version of the U.S. Bancorp article was accessible to members of the public prior to Appellants' filing date. Appellants challenge the alleged creation (and/or alleged publicly accessible) date of the electronic document as the date of this reference for "prior art" purposes. Nor has the Office shown that the information relied upon in the electronic document version was identical to an earlier-published non-electronic copy version. Therefore, the relied upon U.S. Bancorp article does not constitute a printed publication nor prior art. Appellants further respectfully request that the rejections be withdrawn on this basis.

### **The 35 U.S.C. § 103 Rejections Are Traversed**

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

As noted above, the U.S. Bancorp article does not constitute prior art. Nevertheless, even if it were somehow possible for the U.S. Bancorp article to constitute prior art, it still would not have been obvious to have modified the U.S. Bancorp article to have produced the claimed invention.

Appellants' arguments against the rejections are based on the Office's interpretation of the reference as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the reference by the Office would constitute a new ground of rejection.

The Action admits (page 4) that U.S. Bancorp fails to disclose or suggest that an "automated banking machine PC has a sheet dispenser mechanism operatively responsive to receipt of at least one HTML format document by the browser, so as to dispense at least one sheet from the automated banking machine PC." The Action also admits (page 5) that U.S. Bancorp fails to disclose or suggest that the "system can be used in an ATM machine to remotely access the on-line bank." That is, the Action admits that U.S. Bancorp lacks:

- 1.) An automated banking machine having a sheet dispenser mechanism.
- 2.) An automated banking machine having a sheet dispenser mechanism operatively responsive to receipt of a document by a browser.

- 3.) An automated banking machine that is able to dispense at least one sheet based on receipt of a document by a browser.
- 4.) Use in an ATM machine.
- 5.) Use in an ATM machine to remotely access an on-line bank.

Appellants agree that U.S. Bancorp is deficient in the features for which it is relied upon. Appellants respectfully submit that U.S. Bancorp lacks many more of the recited features and relationships. Thus, the 35 U.S.C. § 103(a) rejections should be withdrawn.

The Action asserts "official notice" concerning several features. Appellants respectfully traverse the official notice assertions on the basis that they are not supported by any reference to prior art. The Office is not permitted to rely merely on assertions of "official notice" as the basis for rejecting claims. Furthermore, when challenged the Office is required to establish such assertions in the proper manner through citation to prior art. Appellants challenge all official notices. Appellants respectfully traverse the rejections and require the Office to support a rejection of the features and relationships recited in the claims, with citation to relevant art as required by MPEP § 2143.03 and 2144.03. In the absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn.

Furthermore, the Action relies on the ordinary skill level in the art. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references (MPEP § 2143.01). Therefore, the Office has not presented a *prima facie* showing of obviousness.

Furthermore, the Action admits that U.S. Bancorp does not disclose or suggest all of the recited features and relationships. Therefore, even if it were somehow possible to combine

reference features (which it isn't) this would not render the resultant combination obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01).

Furthermore, the only alleged "motivation" is that gleaned from Appellants' own specification. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). The Office has not presented a *prima facie* showing of obviousness. Therefore, the rejections are improper and should be withdrawn.

Additionally, as discussed in further detail herein, the Office incorrectly ascertains the level of ordinary skill in the art at the time of the invention. The Office loosely applies the level of ordinary skill in the art of today with the level of ordinary skill in the art at the time the invention was made. Note the Declaration filed July 10, 2001 establishing reduction to practice prior to February 16, 1996. Appellants respectfully request that the rejections be withdrawn on this basis.

### **Claim 31**

Claim 31 relates to an automated banking machine comprising a browser operating in a computer, and a sheet dispenser mechanism in operative connection with the computer. The sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser to dispense at least one sheet.

The Action (page 4) alleges that "at the time the invention was made that web browsers read web pages and are capable of receiving HTML format documents, and the HTML

documents can contain embedded instructions therein such as applets." Appellants disagree. The Office is confusing the level of ordinary skill in the art today with the level of ordinary skill in the art at the time the invention was made. Appellants assert that no prior art evidence has been made of record to support such an allegation. Nor does U.S. Bancorp disclose or suggest HTML format documents or HTML documents containing embedded instructions therein such as applets. Nor does U.S. Bancorp disclose or suggest HTML documents containing embedded instructions therein in relation to a sheet dispenser mechanism. Nor does U.S. Bancorp disclose or suggest HTML documents containing embedded instructions therein in relation to a sheet dispenser mechanism in an automated banking machine. The Action admits that U.S. Bancorp doesn't even have an automated banking machine with a sheet dispenser mechanism. Nor does U.S. Bancorp have the capabilities to dispense at least one sheet from an automated banking machine. Nor does U.S. Bancorp provide any operative association or link between an automated banking machine sheet dispenser mechanism and an HTML document. Nor is there any suggestion or motivation to provide such an operative association or link.

Appellants challenge the rationale that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have "HTML web pages controlling the functioning of any and all of the myriad of banking functions of the US BANKER PC including the function of dispensing of at least one sheet or note from a printer associated with the PC." That is, Appellants disagree with the Office's allegation that it would have been obvious to have HTML web pages control the banking functions of a home PC, including controlling a PC printer.

Again the Office is confusing the level of ordinary skill in the art of today with the level of ordinary skill in the art at the time the invention was made. Appellants request prior art evidence of "web pages controlling" the banking functions of a home PC, as alleged by the Office. Appellants also request prior art evidence of web pages "controlling" the dispense of "at least one sheet or note from a printer associated with the PC", as alleged by the Office. U.S. Bancorp does not disclose or suggest such features. Furthermore, it would not have been obvious to one having ordinary skill in the art at the time of the invention for a user of a home PC to release control of their PC and printer to outside web pages. Even today's level of ordinary skill in the art would find it highly unlikely that a home PC user would grant permission for unknown (and potentially virus containing) HTML web pages to control their home printer or have access to their home PC system.

It follows that U.S. Bancorp's home banking PC cannot constitute the recited automated banking machine. Nor can a PC printer constitute the recited sheet dispenser mechanism. Not only has the recited relationship between a sheet dispenser mechanism and an HTML document not been shown, but it has also not been shown in an automated banking machine environment. Nor has the Action explained how U.S. Bancorp could have been modified to have included the recited features and relationships. Nor would it have been obvious to have modified U.S. Bancorp to have produced the recited invention.

Furthermore, even if it were somehow possible for U.S. Bancorp to have a home PC constitute an automated banking machine (which U.S. Bancorp doesn't in the manner recited), then there would still be no indication that a home PC printer would be capable of dispensing a

sheet responsive to receipt of an HTML document by a browser. That is, a modified U.S. Bancorp would still not disclose or suggest an automated banking machine involving a computer, browser, sheet dispenser mechanism, and HTML document relationship in the manner recited. Therefore, it would not have been obvious to have modified U.S. Bancorp to have produced the claimed invention. Thus, the Office has not presented a *prima facie* showing of obviousness.

**Claim 35**

Claim 35 relates to an automated banking machine comprising a browser operating in a computer, a card reader in operative connection with the computer, and a sheet dispenser mechanism in operative connection with the computer. The computer is operative responsive to reading indicia on a card with the card reader to cause the browser to receive at least one document. The computer is operative responsive to receipt of at least one document by the browser to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the automated banking machine.

Note Appellants remarks concerning claim 31, which are incorporated herein by reference. As previously discussed, the Action admits (page 4) that U.S. Bancorp fails to disclose or suggest that an automated banking machine PC has a sheet dispenser mechanism operatively responsive to receipt of at least one document by a browser, so as to dispense at least one sheet. Appellants respectfully submit that U.S. Bancorp also does not operatively relate reading card indicia to causing a document to be received by a browser, nor further enabling a sheet dispenser mechanism to dispense a sheet responsive to receipt of a document. The Action admits that U.S. Bancorp doesn't even have an automated banking machine with a sheet

dispenser mechanism. Appellants respectfully submit that U.S. Bancorp also does not disclose or suggest a card reader. U.S. Bancorp does not disclose or suggest any structure or software that would permit reading indicia on a card. Nor would it have been obvious to have provided the home PC of U.S. Bancorp with a card reader. Why would U.S. Bancorp's home PC have any need of a card reader?

The Action then attempts to make up a reason for using a card reader with the home PC of U.S. Bancorp by alleging that it would have been obvious to use the "software and system" of U.S. Bancorp in "a regular ATM machine rather than a home PC, so as to increase on-line banking access to the citizens that did not have a home PC." The Appellants disagree.

The Action admits that U.S. Bancorp does not disclose or suggest use "in an ATM machine to remotely access the on-line bank." That is, the Action admits that U.S. Bancorp does not relate to an ATM (or any corresponding ATM card reader). U.S. Bancorp does not disclose or suggest using an ATM. Furthermore, the Action admits (page 5) that U.S. Bancorp does not disclose or suggest that its "system can be used in an ATM machine." Nor would it have been obvious to have used the home PC of U.S. Bancorp in an ATM. Furthermore, the Action's allegation of using the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. One having ordinary skill in the art would not have considered placing the home PC of U.S. Bancorp in "a regular ATM machine." Even if it were somehow possible (which it isn't) to have placed the home PC of U.S. Bancorp in "a regular ATM machine", it still would not have been structurally capable of teaching the recited features and relationships, nor of



producing the claimed invention. That is, the home PC of U.S. Bancorp (whether in or out of an ATM) would lack the required structure and software of an ATM (and a card reader). Nor would a sophisticated operable "regular ATM machine" have any need of U.S. Bancorp's home PC. Such incorporation of U.S. Bancorp's home PC (or any home PC) into an ATM, if it were even somehow possible, in order to be functionally compatible and operable, would require massive structural and software changes. That is, the originally disclosed home PC of U.S. Bancorp, which is structurally and functionally limited to simple home usage, would no longer exist. The resultant modified ATM, if it were somehow even possible, would have destroyed the disclosed home PC utility of the reference.

A reference teaching away from the recited invention does not support prima facie obviousness. Also, an obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the U.S. Bancorp reference, which is to enable banking transactions to be conducted from home, it is respectfully submitted that the rejection is improper and should be withdrawn

The Action further alleges that "ATM machines remotely accessing banking system were well known to the general citizenry at the time that the invention was made." The Appellants disagree. No prior art evidence has been made of record to support such an allegation. ATMs at the time that the invention was made were operated in proprietary communication networks. The Office has provided no evidence of ATMs using a browser or accessing an on-line bank. Nor

does U.S. Bancorp disclose or suggest the recited relationships among a computer, card reader, card indicia, document, browser, and sheet.

As previously discussed, the Action alleges that it would have been obvious to use the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC, so as to increase on-line banking access to the citizens that did not have a home PC." The Appellants disagree. The alleged "motivation" must be clearly and particularly identified in the prior art. No motivation is provided in the U.S. Bancorp article to remove a home PC out of the home PC environment. It follows that it would not have been obvious to have used the home PC of U.S. Bancorp in "a regular ATM machine." Nor has the Office explained why it would have been obvious to force citizens to travel to a remote site (away from home) "so as to increase on-line banking access to the citizens that did not have a home PC" instead of taking more appropriate action, e.g., such as providing citizens with free or low cost home PCs. Thus, the Office's alleged motivation for modifying the teaching of U.S. Bancorp is contrary to both the teaching of U.S. Bancorp and to one having ordinary skill in the art.

Furthermore, the Action is silent as to how the home PC of U.S. Bancorp could be operationally included in "a regular ATM machine." As previously discussed, the home PC of U.S. Bancorp (even if modified as alleged) would not teach the recited features and relationships. Thus, nor would the home PC of U.S. Bancorp if somehow placed in "a regular ATM machine" teach the recited features and relationships. Furthermore, there would be no motivation for a citizen to use the alleged modified ATM (having the home PC of U.S. Bancorp) when they could use a full service branch or even an existing "regular ATM machine" upon leaving their home.

Nor is there any indication or evidence that the alleged modified ATM would be able to serve citizens any better or have more availability than a full service branch or an existing "regular ATM machine." Furthermore, PC home banking is based on user convenience. There is no indication in U.S. Bancorp that convenience would be increased by forcing the customer to leave the home PC environment. Contrarily, one having ordinary skill in the art would find that a citizen in the Action's alleged scenario would actually be inconvenienced. The entire U.S. Bancorp article is directed to using a home PC. Thus, the Action's allegation of using the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. Such allegation would result in destroying the disclosed utility or advantage of the U.S. Bancorp reference. *In re Fine, supra*. Thus, the rejection is improper and should be withdrawn.

Additionally, the only suggestion for producing the Office's alleged ATM is found in Appellants' own novel disclosure. It follows that the alleged modification of U.S. Bancorp (and the rejection) is based on hindsight reconstruction from Appellants' disclosure, which is impermissible. The Office has not presented a *prima facie* showing of obviousness. Therefore, it would not have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention.

### **Claim 38**

Claim 38 recites some subject matter similar to subject matter in claim 35. Claim 38 recites "HTML document handling software" instead of the "browser" of claim 35. Appellants' remarks in support of the patentability of claim 35 are incorporated by reference as if fully

rewritten herein. Thus, it is respectfully submitted that claim 38 also patentably distinguishes over the reference.

As previously discussed, the Office has not presented a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claim 41**

Claim 41 recites some subject matter similar to subject matter in claim 35. Claim 41 recites "document handling software" instead of the "browser" of claim 35. Claim 41 also recites a "note dispenser" instead of the "sheet dispenser mechanism" of claim 35. Thus, the computer is operative to control the note dispenser in dispensing at least one note responsive to at least one document. Appellants' remarks in support of the patentability of claim 35 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 41 also patentably distinguishes over the reference.

As previously discussed, claim 41 recites an automated banking machine comprising a "note dispenser." Appellants Specification at page 9, lines 24-26 indicates that a "note" in an automated banking machine relates to currency. U.S. Bancorp does not relate to bank note dispensing. U.S. Bancorp is not capable of printing (counterfeiting) a note with a home PC, which (if somehow possible) would have been illegal. Nor would such an (illegal) action have been obvious to one having ordinary skill in the art. The home PC system of U.S. Bancorp is not capable of dispensing a bank note. It follows that U.S. Bancorp's home banking PC cannot

constitute the recited automated banking machine. Nor can a printer associated with the home PC constitute the recited note dispenser.

Furthermore, as previously discussed, it would not have been obvious to have used the home PC of U.S. Bancorp in an ATM. Furthermore, the Action's allegation of using the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. Even if it were somehow possible (which it isn't) to have placed the home PC of U.S. Bancorp in "a regular ATM machine", it still would not have been structurally capable of teaching the recited features and relationships, nor of producing the claimed invention. That is, the home PC of U.S. Bancorp (whether in or out of an ATM) would lack the required structure and software to dispense a bank note. It follows that even if it were somehow possible (which it isn't) to use the home PC system of U.S. Bancorp in an ATM, it still would not have been capable of dispensing a bank note. Nor would a sophisticated operable "regular ATM machine" have any need of U.S. Bancorp's home PC. As previously discussed, such incorporation of U.S. Bancorp's home PC (or any home PC) into an ATM, if it were even somehow possible, in order to be functionally compatible and operable, would require massive structural and software changes. That is, the originally disclosed home PC of U.S. Bancorp, which is structurally and functionally limited to simple home usage, would no longer exist. The resultant modified ATM, if it were even somehow possible, would have destroyed the disclosed home PC utility of the reference. *In re Fine, supra.*

As previously discussed, the Office has not presented a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Claim 44**

Claim 44 relates to an automated banking machine comprising a note dispenser mechanism and a computer. The computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine.

Appellants' remarks in support of the patentability of claim 41 are incorporated by reference as if fully rewritten herein. As previously discussed (e.g., claim 41), U.S. Bancorp does not relate to bank note dispensing. The Action admits that U.S. Bancorp doesn't have an automated banking machine with note dispensing. Nor has the Office presented any evidence that U.S. Bancorp is even capable of receiving a mark up language document. Nor is there any teaching or suggestion in U.S. Bancorp that its home PC is adapted to operate responsive to a mark up language document to cause a note to be dispensed. Nor does U.S. Bancorp provide any operative association or link between being responsive to a mark up language document and dispensing of a note. Nor is there any suggestion or motivation to provide such an operative association or link.

As previously discussed, U.S. Bancorp's home PC cannot constitute the recited automated banking machine. Nor can a PC printer combined with U.S. Bancorp's home PC overcome the deficiencies of the U.S. Bancorp article. That is, even is it were somehow possible for U.S.

Bancorp's home PC to be combined with a printer, the combination would still not permit the recited relationship among the computer, document, and note dispensing.

Appellants' remarks in support of the patentability of claim 35 are also incorporated by reference as if fully rewritten herein. As previously discussed (e.g., claim 35), it would not have been obvious to have used the home PC of U.S. Bancorp in an ATM to have produced the claimed invention. Any allegation of using the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. Such an allegation would result in destroying the disclosed utility or advantage of the U.S. Bancorp reference. *In re Fine, supra*.

As previously discussed, the Office has not presented a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claim 45**

Claim 45 depends from claim 44 and further recites a card reader in operative connection with the computer. The computer is adapted to operate responsive to indicia read by the card reader to cause the computer to receive the at least one mark up language document. Furthermore (claim 44), the computer is adapted to operate responsive to at least one mark up language document to cause at least one note to be dispensed from the banking machine.

As previously discussed (e.g., claim 35), U.S. Bancorp does not disclose or suggest a card reader. U.S. Bancorp does not disclose or suggest any structure or software that would permit

reading indicia on a card. Nor would it have been obvious to have provided the home PC of U.S. Bancorp with a card reader. Nor does U.S. Bancorp disclose or suggest the recited relationships among a card reader, indicia, document, computer, and note dispenser. Nor would it have been obvious to have used the home PC of U.S. Bancorp in an ATM to have produced the claimed invention. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Claims 48-50**

Appellants bring to the Board's attention that claims 48-50 each include an obvious typographical error. In line 1 of each claim "method" should read "machine". It is noted that the Office did not object to (or make Appellants aware of) the language in the Action. Furthermore, the Office correctly grouped the claims with Group III, which was directed to an automated banking machine, instead of with the method of Group IV or V. Additionally, note the similar beginning language of claim 54. Appellants authorize correction of these minor informalities by Examiner's amendment.

Claim 48 depends from claim 31 and further recites that the automated banking machine comprises an Automated Teller Machine (ATM), and the sheet dispenser mechanism is operative responsive to receipt of at least one HTML format document by the browser to dispense at least one sheet from the ATM.

Claim 49 depends from claim 35 and further recites that the automated banking machine comprises an Automated Teller Machine (ATM), and the computer is operative responsive to receipt of at least one document by the browser to enable the sheet dispenser mechanism to operate to dispense at least one sheet from the ATM.



Claim 50 depends from claim 38 and further recites that the automated banking machine comprises an Automated Teller Machine (ATM), and the computer is operative responsive to at least one HTML document to enable the sheet dispenser to dispense at least one sheet from the ATM.

As previously discussed, U.S. Bancorp does not disclose or suggest using an ATM. Nor would it have been obvious to have provided the home PC of U.S. Bancorp with an ATM to have produced the claimed invention. The entire U.S. Bancorp article is directed to using a home PC for banking services in the "home." Thus, the Action's allegation of using the home PC system of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. Even if it were somehow possible (which it isn't) to have placed the home PC of U.S. Bancorp in "a regular ATM machine", it still would not have been structurally capable of teaching the recited features and relationships, nor of producing the claimed invention. It follows that the Office has not presented a *prima facie* showing of obviousness.

#### **Claim 51**

Claim 51 relates to an automated banking machine comprising a computer. The computer is adapted to receive at least one mark up language document. The computer is adapted to operate responsive to the at least one mark up language document to cause at least one sheet to be dispensed from the automated banking machine.

Appellants' remarks in support of the patentability of claim 44 are also incorporated by reference as if fully rewritten herein. As previously discussed (e.g., claim 44), there is no

teaching or suggestion in U.S. Bancorp that its home PC is adapted to operate responsive to a mark up language document to cause a sheet to be dispensed. The Action admits that U.S. Bancorp doesn't have an automated banking machine with a sheet dispensing. Nor has the Office presented any evidence that U.S. Bancorp is even capable of receiving a mark up language document. U.S. Bancorp provides no operative association or link between being responsive to a mark up language document and dispensing of a sheet from an automated banking machine. Nor is there any suggestion or motivation to provide such an operative association or link. As previously discussed, U.S. Bancorp's home PC cannot constitute the recited automated banking machine. Nor can a PC printer combined with U.S. Bancorp's home PC overcome the deficiencies of the U.S. Bancorp article. That is, even is it were somehow possible for U.S. Bancorp's home PC to be combined with a printer, the combination would still not permit the recited relationship among the computer, document, and sheet dispensing.

As previously discussed, the Office has not presented a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

#### **Claim 52**

Claim 52 depends from claim 51 and further recites that the sheet comprises a note.

As previously discussed (e.g., claims 41 and 44), U.S. Bancorp does not relate to bank note dispensing. Nor would it have been obvious to have used of the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC" to have produced the claimed invention.

Appellants' remarks in regard to claim 41 are incorporated by reference herein. It is respectfully submitted that the Office has not presented a *prima facie* showing of obviousness.

**Claim 53**

Claim 53 depends from claim 52 and further recites that the note comprises cash.

U.S. Bancorp does not relate to cash dispensing from an automated banking machine. The Action attempts to provide a reason for dispensing cash with the home PC of U.S. Bancorp by alleging that it would have been obvious to use the "software and system" of U.S. Bancorp in "a regular ATM machine rather than a home PC." As previously discussed, the Appellants disagree.

As previously discussed, it would not have been obvious to have used of the home PC of U.S. Bancorp in an ATM. Furthermore, the Action's allegation of using the home PC of U.S. Bancorp in "a regular ATM machine rather than a home PC", which would be remote from the PC user's home, goes directly against the explicit teaching of U.S. Bancorp. Even if it were somehow possible (which it isn't) to have placed the home PC of U.S. Bancorp in "a regular ATM machine", it still would not have been structurally capable of teaching the recited features and relationships, nor of producing the claimed invention. That is, the home PC of U.S. Bancorp (whether in or out of an ATM) would lack the required structure and software to dispense cash. Nor would a sophisticated operable "regular ATM machine" have any need of U.S. Bancorp's home PC. Such incorporation of U.S. Bancorp's home PC (or any home PC) into an ATM, if it were somehow even possible, in order to be functionally compatible and operable, would require structural and software changes. That is, the originally disclosed home PC of U.S. Bancorp,

which is structurally and functionally limited to simple home usage, would no longer exist. The resultant modified ATM, if it were even somehow possible, would have destroyed the disclosed home PC utility of the reference. *In re Fine, supra*. Again the Office has failed to present a *prima facie* showing of obviousness.

#### **Claim 54**

Claim 54 depends from claim 53 and further recites that the automated banking machine comprises an Automated Teller Machine (ATM). As previously discussed, it would not have been obvious to have used of the home PC of U.S. Bancorp in an ATM. That is, it would not have been obvious to have modified U.S. Bancorp in the manner alleged. Thus, the Office has failed to present a *prima facie* showing of obviousness. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

### **CONCLUSION**

As explained above, each of the claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellant's invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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